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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,280	08/30/2001	Shawn R. Gettemy	PALM-3675	1896

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EXAMINER

WU, XIAO MIN

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,280

Applicant(s)

GETTEMY ET AL.

Examiner

XIAO M. WU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-13, 18-24, 26, 27, 29 and 31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 11, 12, 29 and 31-36 is/are allowed.
- 6) ☒ Claim(s) 13, 18-24, 26, 27, 37 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 18 recites the limitation "said portion" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 13, 19, 21-22, 24, 26-27, 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Fishkin et al. (US Patent No. 6,243,074).

As to claims 13, 24, Fishkin further discloses a portable electronic device comprising: a processor (24) coupled to a bus; a display module (30) for displaying information and coupled to the bus; a memory (26) for storing information and coupled to the bus; an electronic muscle material (22, 28) couple to the bus and for use as an input device, wherein the electronic muscle material generates information used by the processor for detecting the placement of user fingers on the electronic muscle material (see Fig. 4) and further wherein the electronic muscle material

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grows a plurality of function buttons (see Fig. 34) in the proximity of user's fingers responsive to the detection of the placement.

As to claim 19, Fishkin discloses sound detection by vibration which is equivalent to a microphone (see col. 15, lines 19-34).

As to claims 21,27, Fishkin discloses that the movement of the electronic muscle causes the processor to sense handling by user for determination of left-handedness or right-handedness thereof (col. 3, lines 28-37).

As to claims 22, 38, Fishkin discloses that the electronic muscle generates information used by the processor for detecting the identity of a user (e.g. voice identification, see col. 15, lines 27-33 and Fig. 27).

As to claim 26, Fishkin discloses that the locations of the plurality of buttons (or sensors) are defined based on the displacement of the user fingers on the electronic muscle material. For example, the sensor or button can be placed on the edge of the display or on corner of the display, or on the back of the display for left hand fingers and right hand finger (see Figs. 3, Fig. 9, and Figs. 38, 39, respectively).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 18, 20, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fishkin et al. (US Patent No. 6,243,074) in view of Pelrine et al ("Application of Dielectric Elastomer Actuators").

As to claims 18, 20, 36, 37, it is noted that Fishkin does not disclose the electronic muscle material vibrates at a frequency as specified by the processor for use as a speaker. Pelrine is cited to teach an electronic muscle material vibrates at a frequency as specified by the processor for use as a speaker (see Table 3 of Pelrine). It would have been obvious to have modified Fishkin with the features of the electronic muscle material vibrates for use as a speaker as taught by Fishkin so as to eliminate a speaker and reduce the cost. Furthermore, the location of the speaker or the microphone is considered as an obvious design choice since it would have been obvious to one of ordinary skill in the art to have arranged the location of the speaker or microphone in a proper position within the housing.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fishkin et al. (US Patent No. 6,243,074) in view of Pelrine et al ("Application of Dielectric Elastomer Actuators") as applied to claim 13 above, and further in view of Henty (US Patent No. 5,838,138).

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As to claim 23, it is noted that Fishkin as modified discloses the device including a rechargeable battery but fails to disclose the movement of the electronic muscle material cause charging of the battery. Henty is cited to teach a portable computer device which including a mechanical power converter for converting movement of the input device into electrical current to cause charging of the battery (see Fig. 1a, 1b). It would have been obvious to one of ordinary skill in the art to have included a mechanical power converter as taught by Henty into the electronic muscle device of Fishkin as modified, so that the deformation movement of the electronic muscle can generate electrical current for charging the battery, so as to save power.

Allowable Subject Matter

9. Claims 1-7, 11-12, 29, 31-36 are allowed.

Response to Arguments

10. Applicant's arguments with respect to claims 13, 18-24, 26-27, 37-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to XIAO M. WU whose telephone number is 571-272-7761. The examiner can normally be reached on 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PATRICK EDOUARD, can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

x.w.
August 22, 2005


XIAO M. WU
Primary Examiner
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